REMARKS/ARGUMENTS

I. Rejection of Claims under 35 U.S.C. §103

The Examiner has rejected Claims 1-22 under 35 U.S.C. §103(a) as being unpatentable over Tengel, *et al.*, U.S. Patent No. 5,940,812 (Tengel), in view of Levine, *et al.*, U.S. Patent No. 6,233,566B1 (Levine), and Mottola, *et al.*, U.S. Patent No. 5,745,885 (Mottola) . As the Examiner is no doubt aware, determination of obviousness requires consideration of the invention considered as a whole; the inquiry is not whether each element exists in the prior art, but whether the prior art made obvious the invention as a whole. Furthermore, there must be some suggestion or teaching in the art that would motivate one of ordinary skill in the art to arrive at the claimed invention; a reference that teaches away from a claimed invention strongly indicates nonobviousness.

Moreover, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

Tengel describes a loan origination system for matching loans with a potential borrower via a telecommunications network. The system employs a borrower database that gathers and stores information furnished by a potential borrower as well as credit information regarding the borrower supplied by a credit bureau. The system has a loan origination database in which one or more potential lenders have stored loan acceptance criteria and the attributes of their loans. The system

compares the borrower attributes and the loan acceptance criteria to determine which of these loans are available to the potential borrower and ranks such loans for the borrower to make a choice. After the borrower chooses a loan, borrower attributes in the database are used to automatically generate a loan application that is sent to the lender for approval. (Abstract).

Tengal is directed to gathering of information with respect to the issuance of new loans and provides no guidance or insight with respect to combining or refinancing existing loans. Tengal does not directly or indirectly address or suggest gathering information from a loan applicant with respect to a plurality of existing and outstanding loans with a view to qualifying both the applicant and the loans for consolidation. Tengal only provides a mechanism for determining if a potential borrower has the financial wherewithal to withstand the burden of incurring a larger amount of debt and does not teach or suggest a system for reducing a borrower's financial burden by consolidating loans. In addition to not addressing student loans or loan consolidation issues, Tengal also does not address lender contact or interaction with the borrower unless and until the borrower initiates such contact. (Col. 9, lines 60-62).

The Examiner looks to Levine to overcome the shortcomings of Tengal. Levine does not do so for a number of reasons including the fact that the two references are not analogous. The references are not analogous because they deal with vastly different financial disciplines. A person of ordinary skill in the art of lending and loan origination, such as a banker, would hardly be expected to resort to Levine in order to overcome any shortcomings in Tengal. Nor would a person of ordinary skill in the art of purchasing and selling financial instruments, such as a stockbroker, look to Tengal for teachings or suggestions with respect to financial markets. The respective areas of endeavor are quite distinct. Levine does not address any aspect of the loan business such as loan

processing, loan applications, credit assessment, etc. Levine only addresses issues relating to the business of buying and selling financial products. Nothing in Levine suggests that the system described therein could be usefully employed in any aspect of the lending or debt consolidation business.

The Examiner has not set forth any objective factors or reasons that would motivate a person skilled in the pertinent art to combine the teachings of Levine with Tengal. Even if the scope of the cited references are within the scope of analogous art, an objective factor must be given that would motivate the person to refer to the references and then to combine them. The Examiner has not set forth any such objective factor. Other than the statement that Tengal and Levine are within "the same field of endeavor: financial manipulation of loans," (Office Action, para 5) the Examiner has not pointed to any specific teaching in Levine or Tengal that would provide the requisite motivation required by case law as to why a skilled person, with no knowledge of the claimed invention, would have made this combination in the manner claimed. There is no specificity given by the Examiner regarding the necessary motivation to combine these references. As stated by the Federal Circuit in the fairly recent case of *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002):

> The need for specificity pervades this authority. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reasons the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffett*, 149, F3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the would have been motivated to select the references and to combine to render the claimed invention obvious.") *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780,

1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

Further support for the Applicant's position is found in *In re* Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990), where the Court states that "[t]he mere fact that ... disclosures can be combined does not make the combination obvious unless the art also contains something to suggest the desirability of the combination." *In re* Imperato. 486 F. 2d 585, 587, 179 USPQ 730, 732 (CCPA 1973). "The mere fact that the prior art could be modified in the manner proposed by the examiner would not have made the modification obvious unless the prior art suggested the desirability of the modification." *Ex parte* Dussaud, 7 USPQ1818, 1820 (Bd. App. & Int'f 1986).

In addition to disagreeing with the Examiner's position that Tengal and Levine are within the same field of endeavor, as discussed above, and that no motivation is given to combine the two, the Applicant also respectfully disagrees with the Examiner's statement that both deal with the "financial manipulation of loans." Levine does not address any aspect of the issuance or manipulation of loans or loan terms. Levine addresses the marketing of financial instruments of which loans are but one type. Levine deals with loans as a product and the manipulation of a market for such loans, whereas Tengal deals with the creation or manipulation of loans and their terms that, when completed, may or may not become one such product. Stated slightly differently, Tengal addresses the field of lending and creating loans by manipulating the loan structure, whereas Levine addresses manipulating a market for investments. It is well established by those skilled in the relevant arts that the two types

of endeavor are quite distinct from each other, both as to the necessary skills brought to bear as well as the subject matter itself. Tengal and Levine address clearly defined separated fields of well recognized endeavors and to suggest otherwise is, at best, speculative. The mere fact that isolated references are found to establish a combination does not render the combination obvious unless something suggests the desirability of the combination, which is not the case here. Tengel, individually or in combination with Levine, thus fails to teach or suggest the invention recited in independent Claims 1, 9 and 16 and their dependent claims, when considered as a whole. Claims 1-22 are therefore not obvious in view of Tengel and Levine.

The system described in Mottola also does not overcome the shortcomings in Tengal. In fact, Mottola disparages student loans and uses their perceived shortcomings as justification for its alternative higher education funding plan. Mottola this teaches away from using student loans to finance a loan applicant's higher education. (Col. 1, lines 15-67; Col. 2, lines 1-13). Mottola is directed solely to a "method and apparatus for implementing and administering a plan of investments for financing higher education". (Col. 1, lines 17-18). Mottola does not include loans in the plan of investment nor does Mottola describe or suggest the consolidation of outstanding student loans.

Tengel, individually or in combination with Mottola, thus fails to teach or suggest the invention recited in independent Claims 1, 9 and 16 and their dependent claims, when considered as a whole. Claims 1-22 are therefore not obvious in view of Tengel and Mottola. In view of the foregoing remarks, the cited references do not support the Examiner's rejection

of Claims 1-22 under 35 U.S.C. §103(a). The Applicant therefore respectfully requests the Examiner to withdraw the rejection.

II. Conclusion

In view of the foregoing remarks, the Applicant now sees all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicits a Notice of Allowance for Claims 1-22.

The Applicant requests the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application.

Respectfully submitted,

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